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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,376

10/19/2005

Ken Inose

TOYA114.011APC

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EXAMINER

BERTAGNA, ANGELA MARIE

ART UNIT	PAPER NUMBER
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1637

NOTIFICATION DATE	DELIVERY MODE
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12/07/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/553,376

Applicant(s)

INOSE ET AL.

Examiner

Angela Bertagna

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-5, 9 and 10.

Claim(s) withdrawn from consideration: 6-8.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

Continuation of 3a. Claim 1 has been amended to recite that the fraction of nucleic acids collected after the gel filtration step is a solution of nucleic acids. This limitation has not been previously considered, and therefore, the amendment presents new issues that require further search and consideration.

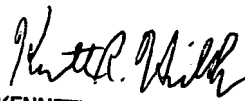
Continuation of 11. Applicant's arguments have been fully considered but were not found persuasive.

Regarding the rejection of claims 1, 2, 9, and 10 under 35 U.S.C. 102(b), Applicant argues that the agarose gel electrophoresis step taught by Pierre is not a gel filtration step as required by the claim 1 (see page 3). This argument was not found persuasive, because gel filtration is not limited to methods conducted in column chromatography format. Rather, the broadest reasonable interpretation of a gel filtration step includes any method wherein molecules are passed through a gel in order to achieve fractionation based on size. Since the agarose gel electrophoresis step taught by Pierre separates nucleic acids moving through a gel based on their size, it is a gel filtration method. However, it is noted that the amendment of the claims to recite the that fraction of nucleic acids collected is a solution of nucleic acids would be sufficient to overcome the rejection citing Pierre if entered. As noted above, the amendment requires further search and consideration, and as a result, has not been entered. Since the amendment has not been entered, the rejection has been maintained.

Regarding the rejection of claims 1-5, 9, and 10 under 35 U.S.C. 103(a) as unpatentable over Burdick in view of Akane, Applicant argues that Akane does not suggest incorporating a gel filtration step into a method of isolating nucleic acids that avoids the use of organic solvents and multiple centrifugation steps (see page 4). Applicant argues that the claimed gel filtration step eliminates excess salt that would interfere with downstream PCR applications, and that this concept is not taught in either the Burdick or Akane reference (see page 4).

Applicant's first argument was not found persuasive, because Burdick teaches a method for isolating nucleic acids without the need for organic solvent extraction or multiple centrifugation steps (see columns 6, 12, and 14, cited previously). Burdick expressly teaches that an advantage of the disclosed method is its avoidance of organic solvents and lengthy separation procedures (column 4, last paragraph). As discussed previously, an ordinary artisan would have been motivated to incorporate the gel filtration step taught by Akane into the method of Burdick in order to remove contaminating degraded DNA that could interfere with the subsequent PCR step taught by Burdick. Thus, the combined teachings of Burdick and Akane result in a method wherein a gel filtration step is incorporated into a method for isolating nucleic acids that does not require extraction with organic solvents or multiple centrifugation steps.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., eliminating excess salt that would interfere with subsequent PCR using gel filtration) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the claims only recite heating a nucleic acid-containing sample that has been dissolved in a solution comprising a salt of a monovalent cation and a surfactant and performing gel filtration on the heated solution to obtain isolated nucleic acids. The claims do not further recite that the gel filtration step removes excess salt. Furthermore, the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art, specifically that the gel filtration step eliminates excess salt that is detrimental to downstream PCR processes, cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Since the combined teachings of Burdick and Akane result in the claimed method for the reasons discussed in the Final Rejection and above, the rejection has been maintained.


KENNETH R. HORLICK, PH.D.
PRIMARY EXAMINER

12/3/07